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REMARKS

Claims 1-29 are currently pending in the subject application and are presently under consideration. Claims 1, 3, 12, 25, and 27 have been amended and are believed to be in accordance for allowance.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1 and 3 Under 35 U.S.C. §112, first paragraph

Claims 1 and 3 stand rejected under 35 U.S.C. §112, first paragraph as being indefinite. Applicant respectfully requests the Examiner to withdraw the rejection without prejudice for claims 1 and 3 accordingly.

II. Rejection of Claim 13 Under 35 U.S.C. §112, first paragraph

Claim 13 stands rejected under 35 U.S.C. §112, first paragraph for insufficient antecedent basis. Claim 12 has been amended as such to provide the necessary antecedent basis for the limitation "charging components." Applicant's representative respectfully requests withdrawal of this rejection in view of the herein amendments to the subject claims.

III. Rejection of Claims 1, 2, 3, 5, 6, 16, 17, 18, 20, and 29 Under 35 U.S.C. §103 (a)

Claims 1, 2, 3, 5, 6, 16, 17, 18, 20, and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe (U.S. 5,659,887) in view of Shawver (U.S. 5,996,956). Applicant's representative respectfully requests withdrawal of this rejection for at least the following reasons. Neither Ooe nor Shawver alone or in combination teach or suggest the claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. See MPEP §706.02(j). The **teaching or suggestion to make the claimed combination** and the reasonable expectation of success **must both be found in the prior art and not based on applicant's disclosure**. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In particular, independent claim 1 recites a latch located near an opening, **the latch having an upper surface movable relative to the base** between a first position and a second position; in the first position, the **upper surface being planar to the base** to facilitate insertion and removal of the hand-held device; in the second position, the upper surface being spaced from the base in a direction that the sidewalls extend from the base. Ooe teaches a hands-free cellular phone mount - Ooe does not teach or suggest a latch which is movable in a same plane as the base as in applicant's claimed invention.

Additionally, the Office Action cites Shawver to cure the aforementioned deficiencies of Ooe; however, Shawver does not teach or suggest the claimed latch of applicant's invention. Shawver simply utilizes snap-in tabs - a tab and/or plurality of tab members extending from a platform member disposed to removably secure an electronic device to the front mounting surface. (See Col. 2, lines 8-11). As depicted in Fig. 1, the movable tabs 12, controlled by button 20, are spring loaded toward fixed tabs 10, which are located on the base of the electronic device. (See Col. 3, lines 24-28). The direction in which the tabs 12 move are in Y+ and Y- directions. The tabs are spring loaded, but **are not movable within a same plane as the base** of the electronic device.

The Office Action further references element 14 of Fig. 2 to teach or suggest a latch as in the present claimed invention. However, element 14 of Fig. 2 is merely a spring. Moreover, such spring has an opposite effect as in applicant's claimed latch. The spring cannot act as a latch to secure the electronic device as stated in the claimed invention. (See application pg. 8, lines 12-15).

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More particularly, the claimed invention utilizes a latch in which *the movement is planar to the base* facilitating the insertion and removal of the hand-held device. The latch translates along the Z axis which is perpendicular to the Y axis. Additionally, the latch moves in a direction perpendicular to the direction the device is inserted into or removed from the cradle. (See application pg. 8, lines 12-15). As defined in the application, the device is inserted and removed along the Y - and Y + respectively; while the latch moves along the Z axis. Shawver, on the other hand, utilizes spring loaded tabs that move in the same direction the device is inserted into or removed from the cradle. Using the directions from the present invention, the tabs in Shawver move in the Y - and Y + directions, while the device is also inserted and removed in the Y - and Y + directions. Thus, the movement in Shawver is *not planar to the base* as depicted in the present invention but rather perpendicular to the base. Thus Shawver does not teach or suggest a latch having an *upper surface movable relative to the base* as in applicant's invention as recited in the subject claims.

Regarding independent claim 18, Ooe alone or in combination of Shawver does not teach or suggest a method of *depressing the latch when removing the device*. Rather Ooe simply teaches a hands-free cell phone mount and Shawver teaches a button-activated release for snap-in tabs. Shawver does not teach *depressing of the latch* when removing the electronic device from a housing as in applicant's claimed invention - depressing of the latch itself allows the removal of the electronic device. Shawver merely teaches pressing a separate button, which is not considered to be a latch as defined *supra*, providing release of the device.

Moreover, Shawver teaches away from the present invention. The Federal Circuit has held that teaching away from the art of the subject invention is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Additionally, a prior art reference must be considered in its entirety, e.g., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

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If one of ordinary skill in the art attempts to depress the latch on the Shawver invention, there would be no release of the device. In fact, the device would be more securely placed. In other words, depressing the tabs on the Shawver invention would create a Z- force in which the tabs would not react since the tabs (fixed 10 or movable 12 in Fig. 2) can only be released by a force in direction Y+. Although Shawver teaches a button for the release of such device from a housing, the button is not a latch as defined by the present invention. (See application pg 8, lines 13-15).

Regarding claim 29, Shawver does not teach or suggest an upper surface of the latching component *movable in the same plane* as the base. Shawver teaches tabs that move in the Y+ and Y- direction, which is perpendicular to the base, not planar. Moreover, the movement of tabs in Shawver is perpendicular to the direction of the latch claimed in the present invention. The latch in the present invention moves in a Z+ and Z- direction (e.g., lying in the same plane as the base). The Office Action also states that Shawver teaches the upper surface of the latch being contoured in accordance to the shape of a hand held device to promote insertion and removal of the device citing Fig. 2, element 14. (See Paper 3, pg. 5). However, such reliance is based on the spring 14 which, as described and utilized in Shawver, cannot possibly act as a latch as in the claimed invention to promote insertion and removal of the electronic device.

In view of at least the aforementioned reasons, the subject invention as recited in independent claims 1, 18 and 29 (of which claims 2-17, 19-24 respectively depend upon) is not obvious over Ooe and Shawver, taken individually or in combination. Accordingly, this rejection should be withdrawn.

IV. Rejection of Claims 7, 8, 10, 19, and 20 Under 35 U.S.C. §103(a)

Claims 7, 8, 10, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe in view of Shawver and further in view of Desai, *et al.*, (U.S. 6,344,727). This rejection should be withdrawn for at least the following reasons.

As stated *supra*, neither Ooe nor Shawver alone or in combination teach or suggest applicant's invention as recited in independent claims 1 and 18 (of which claims 7, 8, 10, 19, and 20 depend therefrom). Neither Ooe nor Shawver teach or suggest a

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latch capable of *planar movement in relation to the base* and release by depressing the latch. Moreover, Desai, *et al.* does not cure the aforementioned deficiencies of Ooe and Shawver.

In view of at least the aforementioned reasons, the subject invention as recited in independent claims 1 and 18 (of which claims 7, 8, 10, 19, and 20 depend upon) is not obvious over Ooe, Shawver, and Desai, *et al.*, taken individually or in combination. Accordingly, withdrawal of this rejection and allowance of claims 7, 8, 10, 19, and 20 are respectfully requested.

V. Rejection of Claims 9, 15, and 24 Under 35 U.S.C. §103(a)

Claims 9, 15, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe and Shawver and further in view of Derr, *et al.*, (U.S. Patent No. 6,634,494). Applicant respectfully requests Examiner withdraw the rejection for these claims for at least the following reasons.

Claims 9, 15, and 24 are dependent upon independent claims 1 and 18. As stated *supra*, Ooe and Shawver do not teach or suggest the claim limitations as recited. Additionally, Derr, *et al.* does not cure the aforementioned deficiencies. In view of at least the aforementioned reasons, the withdrawal of the rejection of claims 9, 15, and 24 are respectfully requested.

VI. Rejection of Claims 11, 12, 21, and 22 Under 35 U.S.C. §103(a)

Claims 11, 12, 21, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe and Shawver and further in view of Weissappel, *et al.*, (U.S. Patent No. 6,141,569). Applicant respectfully requests Examiner withdraw the rejection for these claims for at least the following reasons.

Examiner relies upon Weissappel, *et al.* to cure the aforementioned deficiencies of Ooe and Shawver. However, Ooe, Shawver nor Weissappel *et al.* teach or suggest all of the elements of the claimed invention. Claims 11, 12, 21 and 22 are dependent upon claims 1 and 18. Accordingly, withdrawal of this rejection and allowance of claims 11, 12, 21, and 22 are respectfully requested.

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VII. Rejection of Claims 13, 14, and 23 Under 35 U.S.C. §103(a)

Claims 13, 14, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe, Shawver and Weissshappel, *et al.* and further in view of Vance (U.S. 6,389,302). Applicant respectfully requests withdrawal of this rejection for at least the following reasons. Claims 13, 14 and 23 respectively depend from independent claims 1 and 18. As stated *supra*, Ooe, Shawver and Weissshappel, *et al.* do not teach or suggest the limitations recited in these independent claims.

Moreover, Vance does not make up for the deficiencies of these references let alone teach or suggest charging components being spring-loaded *to facilitate the removal of the battery* as incorrectly contended in the Office Action. On the contrary, Vance merely utilizes a spring-loaded system on the battery to provide “the structural resilience to allow the battery to ‘float’ in the direction of the ‘x’ translation axis so that it moves forward and rearward in concert with the repeated forward and rearward deflection of the piezo-ceramic member.” (See Col. 5, lines 52-58). In other words, the spring-loaded system is not utilized to facilitate the removal of the battery but rather allow the battery move in the ‘x’ direction to create a vibrating motion. Vance teaches a vibration technique utilizing the battery of a radiotelephone in which the battery contact springs allow a negative force to produce a repetitive motion not to facilitate the removal of the battery. Thus, Vance does not provide motivation within itself to effect the purported combination absent impermissible employment of applicant’s specification as a 20/20 hindsight based road map. Accordingly, withdrawal of this rejection and allowance of claims 13, 14 and 23 is respectfully requested.

VIII. Rejection of Claim 25 Under 35 U.S.C. §103(a)

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe in view of Shawver in further view of Weissshappel, *et al.* This rejection should be withdrawn for at least the following reasons.

Independent claim 25 recites *latching and releasing the hand held device utilizing a latch movement planar to the base*. As noted above, the cited references doe

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not teach or suggest such feature of applicant's claimed invention; and withdrawal of this rejection is respectfully requested.

IX. Rejection of Claim 27 Under 35 U.S.C. §103(a)

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe in view of Shawver and further in view of Derr, *et al.* Applicant's representative respectfully requests withdrawal of this rejection for at least the following reasons.

Independent claim 27 has been amended herein to emphasize that the latch movement is planar to the base. The cited references do not teach or suggest such aspect of the invention, and this rejection should be withdrawn.

X. Rejection of Claim 28 Under 35 U.S.C. §103(a)

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ooe, Shawver, and Derr, *et al.* and further in view of Marin (U.S. 4,935,742). Applicant's representative respectfully requests withdrawal of this rejection in view of the following reasons.

Marin does not cure the aforementioned deficiencies of Ooe, Shawver and Derr, *et al.* with respect to independent claim 27 from which the subject claim depends.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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